

### **REMARKS / ARGUMENTS**

The present application includes pending claims 1-29, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USPP 2002/0104099 ("Novak"), in view of USP 6,774,926 ("Ellis"). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

#### **I. EXAMINER'S RESPONSE TO ARGUMENTS**

The Examiner states the following at page 2 of the Office Action:

Applicant's arguments filed 04/01/2010 have been fully considered but they are not persuasive.

(1) In response to applicant's argument that Novak (US 2002/0104099) discloses "two distinct roles for user within the media system," the examiner respectfully disagrees. As has been previously explained the upload source 122 and set top box 152 can be the same device ([0061]). The distinction between uploaders and users is for explanation purposes only and it is clear from Novak's complete disclosure that the two roles can be played by the same device, stb 152.

(2) In response to applicant's argument (Remarks pg. 16) that Novak does not disclose "receiving authentication information associated with a first user of the first communication device, and facilitating a display of a user-defined selection from the media content by the first communication device in a user-defined layout," the examiner respectfully disagrees. Novak requires a password to view the synthetic channel ([0084]) and the synthetic channel is arranged by the user ([0063]).

In reference to Examiner's argument (1) above: Referring to paragraph 0061 and Fig. 5 of Novak, the Applicant points out that Novak does not disclose that the upload source 122 and the STB 156 at a end user location are one and the same entity. Novak, at paragraph 0061, only discloses that the upload source can use various ways to upload data, including a set-top box (such as the STB 152). *Novak never intended (nor is it possible) for "the upload source 122 and set top box 152" to be the same device simultaneously, and Novak's disclosure supports the notion that the upload source 122 cannot be simultaneously an end user.*

For example, the last sentence in paragraph 0061 states that once video recordings are uploaded to a server, they are "subsequently provided to subscribed end users." Obviously, the "subscribed end user" is not the same as the upload source. This is further supported by FIGS. 1-2 and 5. The web site (123, 224 or 506) and the video server (508) can be accessed only by the upload source and not by the end user (clearly seen from one-way connection from the upload source 122/222 to the web site 124/224, as well as a one-way communication path from the camera 502 to STB 504 to web site 506 to server 508).

In reference to Examiner's argument (2) above: The Examiner alleges that "Novak requires a password to view the synthetic channel ([0084]) and the synthetic channel is arranged by the user ([0063])." The Applicant disagrees. As explained in the 09/08/2009 response, Novak (in paragraph 0084) requires a password *from the end*

*user* to view the synthetic channel. In addition, Novak (at paragraph 0063) discloses that the synthetic channel can be arranged. However, such arrangement of the synthetic channel is performed by the uploader, and not by the end user (which are two separate entities as explained in the preceding paragraphs).

### REJECTION UNDER 35 U.S.C. § 103

The MPEP states the following regarding the requirements for establishing a *prima facie* case of obviousness:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" See *id.*, § 2143.01. Furthermore, in order to render the claims obvious, the asserted prior art combination must **teach or suggest each and every claim feature**. See *In re Royka*, 490 F.2d 981 (CCPA 1974) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be

taught or suggested by the prior art)<sup>1</sup>; *see also In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (A proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – **including all its limitations** – with the teaching of the prior art.”)

If a *prima facie* case of obviousness is not established, the Appellant has no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

With these principles in mind, the Applicants now turn to the claim rejections in particular.

## **II. The Proposed Combination of Novak and Ellis Does Not Render Claims 1-29 Unpatentable**

### **A. Independent Claims 1, 12, 16 and 27**

#### **1. The Novak Reference is Deficient. The Examiner Has Not Established That It Would Be Obvious To Combine Novak and Ellis**

With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Novak and Ellis does not disclose or suggest at least the limitation of “wherein the selection from the media content is defined by the

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<sup>1</sup> Emphasis added except where noted otherwise.

first user and corresponds to the received authentication information,” as recited by the Applicant in independent claim 1.

The Office Action states the following:

Consider claim 1, Novak clearly teaches a system for supporting multiple users of a communication device (Fig. 1), comprising:

a first communication device communicatively coupled to a communication network at a first geographic location; (Fig. 3: STB 308 is coupled to the Internet 302, [0045].)

media content disposed in the communication network or the first communication device (Media content can be stored in the STB, Fig. 1 [0032], or on the network, Fig. 3 [0047].), the media content comprising personal media; (The content is user created, [0062].)

a software platform residing on the first communication device ([0077]), the software platform receiving authentication information associated with a first user of the first communication device, (Fig. 11: Access to the synthetic channel can be password protected, [0084].) and facilitating a display of a user-defined selection from the media content by the first communication device (Fig. 11: Block 114, [0085]) in a user-defined layout (Fig. 7: The user defines the layout of the display, [0063].),

wherein the software platform is operable to push the media content wherein the selection from the media content is defined by the first user ([0062]) and corresponds to the received authentication information. (Only authorized users can view the content, [0084])

See Office Action at pages 3-4. With regard to the software platform functionalities, the Office Action relies for support on FIGS. 7 and 11 of Novak. Initially, the Applicant points out that **Novak discloses two distinct roles for users within the media system of FIG. 1 – individuals who upload media (uploaders) and end users (e.g., users of STB 308 or 152).** For example, certain individuals (e.g., upload

source 122) can upload media objects to a server and specify a manner in which the media objects are to be played as a media program to an end user. The media program can be provided to an end user via a synthetic channel, which can be tuned to or selected by the end user as if tuning to a conventional television broadcast channel. See Novak at Abstract and ¶ 0010. Novak, at FIGS. 5-7, discloses how an upload source can organize/schedule the synthetic channel. Novak, at FIG. 11, discloses how an end user receives/views the synthetic channel. In other words, the synthetic channel is set up by the uploader, or the upload source, and it is only viewed by the end user, where the upload source 122 is different from the viewer (end user) of the EPG 153. Steps 1104-1106 of FIG. 11 and the corresponding description in ¶ 0078 relate to the upload source 122, and not to the end-users (the Applicant notes the specific reference that uploaded media is broadcasted to the end users; See lines 10-11 of ¶ 0078). In this regard, the platform used by the upload source 122 in steps 1104-1106 is not used by the end user STB 308.

The Office Action is equating the password entered by the end user for protecting access to the synthetic channel (Novak at ¶ 0084) to Applicant's "authentication information associated with a user of the communication device," as recited in Applicant's claim 1. In other words, Novak's entered password is associated with the end user viewing the EPG 153. However, **the end user does not have any control over what media is included in the media channel as such functionality is reserved for the uploader, or the upload source 122. In this regard, Novak does**

**not disclose “wherein the selection from the media content is defined by the first user”** (of the first communication device, i.e., the end user of STB 308 or 152), as recited in Applicant's claim 1.

Furthermore, the Applicant points out that the Office Action equates Novak's set-top box 308 (or 152) with Applicant's “communication device.” However, Novak does not disclose that the STB 152 has the functionality of pushing media content arranged in user-defined layout, directly via a communication network to a second communication device associated with a second user at a second geographic location for consumption at the second geographic location. Figs. 4 and 5 of Novak disclose that the STB can be used to simply upload personal videos to a server. Novak's STB is not used to push media content that has been arranged in a user-defined layout to another user at another location. Furthermore, Novak's STB uploads the personal video at the server only for purposes of storing it. Novak does not disclose or suggest that the uploaded personal video is also “consumed” at the location of the server. On the contrary, the uploaded personal video information is subsequently communicated to yet another location for purposes of preparing the synthetic channel. **Therefore, Novak also does not disclose or suggest “push the media content arranged in the user-defined layout, directly via the communication network to at least a second communication device associated with a second user at a second geographic location for consumption at the second geographic location,”** as recited in

**Applicant's claim 1.** The Examiner admits that Novak fails to disclose this limitation.

More specifically, the Examiner states:

However, Novak does not explicitly teach the software platform is operable to push content arranged in user-defined layout, directly via the communication network to at least a second communication device associated with a second user at a second geographic location for consumption at the second geographic location.

(See *id.* p. 4). The Examiner then relies on Ellis in an attempt to overcome these deficiencies of Novak:

Compton discloses a processor (paragraph 69, disclosing processor);

In an analogous art, Ellis, which discloses a system for video distribution, clearly teaches the software platform is operable to push content arranged in the user-defined layout, directly via the communication network to at least a second communication device associated with a second user at a second geographic location for consumption at the second geographic location. (Fig. 7: Contributor equipment 102 selects when to push personal television channels to viewer equipment 104. The video content can be sent directly with out initially transmitting the content to server equipment. col. 5 lines 18-22, col. 7 lines 27-47, col. 13 line 66 to col. 13 line 22)

(See *id.*, p. 4). Putting aside for the moment whether or not this is an accurate assessment of Ellis, in proposing to combine Novak and Ellis, the Examiner fails to provide “articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness” in the detailed manner described in KSR.

Specifically, the Examiner is required to provide “some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness.” See *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) quoting *In re Kahn*, 441 F.2d 997,988 (CA Fed. 2006). Put another way, the Examiner should “identify a reason



that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, 127 S. Ct. at 1741. The Examiner should make “explicit” this rationale of “the apparent reason to combine the known elements in the fashion claimed,” including a detailed explanation of “the effects of demands known to the design community or present in the marketplace” and “the background knowledge possessed by a person having ordinary skill in the art.” *Id.*

The Examiner attempts to support the combination of Novak and Ellis as follows:

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Novak by pushing content arranged in the user-defined layout, directly via the communication network to at least a second communication device associated with a second user at a second geographic location for consumption at the second geographic location, as taught by Ellis, for the benefit of distributing a personal television channel without need of network storage devices.

(See *id.*, p. 4). This unsupported, conclusory allegation does not provide “articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness” in the detailed manner described in *KSR*. Instead, the Final Office Action appears to be proposing the combination based solely on improper hindsight. The generic benefit of “distributing a personal television channel without need of network storage devices” is not an articulated reasoning with a rational underpinning, as required by the MPEP. As such, the rejections based on the proposed combination of Novak and Ellis is improper and should be withdrawn.

**2. Even If Combined, the Combination of Novak and Ellis Fails To Disclose Or Suggest All Of The Elements Of Claims 1-29**

Even if Novak and Ellis are combined in the manner suggested by the Office Action, claims 1-29 are still patentable because the resulting combination does not disclose or suggest at least the limitation of “wherein the software platform is operable to push the media content arranged in the user-defined layout, directly via the communication network to at least a second communication device associated with a second user at a second geographic location for consumption at the second geographic location,” as recited by the Applicant in independent claim 1.

The Office Action states the following with regard to the teachings of Ellis:

In an analogous art, Ellis, which discloses a system for video distribution, clearly teaches the software platform is operable to push content arranged in the user-defined layout, directly via the communication network to at least a second communication device associated with a second user at a second geographic location for consumption at the second geographic location. (Fig. 7: Contributor equipment 102 selects when to push personal television channels to viewer equipment 104. The video content can be sent directly with out initially transmitting the content to server equipment. col. 5 lines 18-22, col. 7 lines 27-47, col. 13 line 66 to col. 13 line 22)

See Office Action at p. 4. Ellis discloses a television system, in which individual contributors may make their own videos available to viewers through a communications network such as the Internet. The Examiner relies primarily on Fig. 7 of Ellis, which discloses that a video created by a contributor at user equipment 102 may be distributed to viewers at receiving user equipment 104 via communications network 106

and Internet service provider (ISP) 108. See Ellis at col. 7, lines 33-36. Even though Ellis, at the above citations, discloses that a contributor can distribute a video to receiving user equipment, Ellis is still deficient since it does not disclose that media content **arranged in a user-defined layout** is being directly pushed from one location to another. In fact, Ellis does not even disclose arranging media content in a user-defined layout for purposes of subsequent pushing to another location.

Accordingly, the proposed combination of Novak and Ellis does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claims 12, 16 and 27 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 12, 16 and 27 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

#### **B. Rejection of Dependent Claims 2-11, 13-15, 17-26 and 28-29**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 12, 16 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Novak in view of Ellis has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-11, 13-15, 17-26 and 28-29 depend from independent claims 1, 12, 16 and 27, respectively, and are, consequently, also respectfully submitted to be allowable based on the above arguments.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-11, 13-15, 17-26 and 28-29.

In general, the Office Action makes various statements regarding claims 1-29 and the cited references, which statements are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 1-29 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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